

REMARKS

The above amendment is made solely in response to a claim objection in the Final Office Action mailed November 26, 2004 (paper no. 20041122). Claim 18 has been amended. Claims 1-26 are pending in the present application and stand rejected. The Examiner's reconsideration is respectfully requested in view of the following remarks.

A. Claim 18 stands objected

Claim 18 stands objected due to a minor editorial error. Claim 18 has been amended accordingly. Withdrawal of the objection to claim 18 is respectfully requested.

B. Claim 20 stands rejected under § 112

Claim 20 stands rejected under 35 U.S.C. § 112, first paragraph. The rejection is respectfully traversed. Applicants refer the Examiner to p. 8, lines 8-13 of the application, which states: "In order to support various automation tasks and modularize various steps of the hyperlinking process, a Generalized Hyperlink Specification Language (GHSL) allows for *the author* to specify patterns and contexts *for identifying* sources and *destinations* of links." It is respectfully submitted that the Examiner's assertion that "based on user-defined criteria" is not enabled by Applicant's specification is clearly without merit.

Withdrawal of the rejection to claim 20 under 35 U.S.C. § 112 is respectfully requested.

C. Claims 1-17 stand rejected under § 101

Claims 1-17 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Portions of the claims 1-9 and 11-14 have been amended in response to the rejection. The rejection is respectfully traversed.

First, the Examiner argues that claims 1-17 set forth non-functional descriptive material without setting forth physical structures to produce useful, concrete and tangible results. Applications respectfully disagree. The generic concept and the implementation of hyperlinking is very well understood in the art, as described in the "Description of the Prior Art" in the application. Claims 1-17 set forth modules for automatically hyperlinking documents, which produce a useful, concrete and tangible result. An example of a hyperlinked document is provided by accessing almost any web page on the Internet. A simple search query to Google.com provides a web page with a plurality of hyperlinks. Clearly, any assertion that hyperlinks or a hyperlinked document are not a tangible result is without merit given that we are in the Internet age.

Further, the Examiner asserts that the system of claims 1, 7 and 9 reads on a mental construct/abstract idea or at best a computer program, per se. As asserted above, hyperlinking documents provide the tangible result of a hyperlinked document. The system of claims 1, 7 and 9 produce such hyperlinked documents. In light of the application, hyperlinking is clearly not a mental construct or an abstract idea. The system of claims 1, 7 and 9 also do not read on a computer program, per se. Once again, a system that hyperlinks documents to produce hyperlinked documents is a useful, concrete and tangible result.

Even assuming, *arguendo*, that the system of claims 1, 7 and 9 read on software per se, the Examiner's assertion that software per se is non-statutory subject matter is without support. Applicants respectfully submit that no decision of the Supreme Court, CCPA, Federal Circuit, or the Board of Patent Appeals and Interferences (including its predecessor) has held that computer software constitutes non-statutory subject matter per se. In fact, recent case law (e.g., *Arrhythmia Research Technology Inc. v. Corazonix Corp.*, *In re Alappat*) and the slew of software-based patents being issued weekly by the USPTO indicate otherwise.

If the Examiner is going to rely on the argument that computer software is non-statutory subject matter per se, then Applicants respectfully request the Examiner to support such assertion and identify any cases explicitly and unambiguously holding that computer software is per se non-statutory. Otherwise, withdrawal of the rejection is appropriate.

Withdrawal of the rejection of claims 1-17 under 35 U.S.C. § 101 is respectfully requested.

D. Claim 1 rejected under § 103(a)

Claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Rodkin et al. (U.S. Patent No. 6,092,074) (hereinafter "Rodkin") in view of Liu et al. (U.S. Patent No. 5,794,257) (hereinafter "Liu") and further in view of Foss et al. (U.S. Patent No. 5,404,534) (hereinafter "Foss"). The rejection is respectfully traversed.

Applicants fully maintain the arguments presented in the response to paper no. 11. Applicants now address the Examiner's "Response to Arguments." The Examiner asserts

that col. 2, lines 17-29 and lines 42-58 of Rodkin teach “automatically generating static hyperlinks,” as claimed in claim 1. The Examiner simply refers to portions of the application that generically refer to the word “static” or the term “static links.” In effect, the Examiner is performing a keyword search on the term “static links.”

The recited portions of Rodkin still do not support the Examiner’s argument that Rodkin teaches “automatically *generating* static hyperlinks.” As asserted in the previous response, Rodkin discloses “static links” that are *hard-coded* in documents. A hard-coded link (i.e., a previously-assigned and permanent link) clearly *teaches away* from having a mechanism that *generates* static hyperlinks. The Examiner has not established that Rodkin discloses “automatically *generating* static hyperlinks.” The Examiner’s reference to isolated keywords in the reference is clearly insufficient for establishing prima facie obviousness.

The Examiner further asserts that col. 5, lines 19-32 and col. 6, lines 31-47 of Foss discloses “wherein the source identifier and the source anchor generator support the application of the incremental hyperlinker and the source-level dynamic hyperlinker on document objects at different hyperlinking stages.” Applicants respectfully disagree. The Examiner argues that col. 2, lines 6-14 of Liu teaches “the incremental hyperlinker” and that col. 2, lines 42-58 and col. 3, lines 26-34 of Rodkin disclose “the source-level dynamic hyperlinker.” Assuming, *arguendo*, that the Examiner’s arguments are valid, the Examiner’s citation of col. 5, lines 19-32 and col. 6, lines 31-47 of Foss still do not explain how the combination of references teach that the source identifier and the source anchor generator support the application of the unrelated portions of Liu and Rodkin on document objects, as essentially claimed in claim 1. That is, the Examiner’s argument is

missing critical, logical connections for tying together the disparate references, in essentially the manner claimed in claim 1.

C. Claims 2-26 rejected under § 103(a)

Claims 2-26 rejected under 35 U.S.C. § 103(a) as being unpatentable over Rodkin in view of Liu, and further in view of Foss, and further in view of Chang (U.S. Patent No. 5,694,594) (hereinafter "Chang"). The rejection is respectfully traversed.

Applicants fully maintain the arguments presented in the response to paper no. 11. Applicants now address the Examiner's "Response to Arguments."

Regarding at least claim 18, the Examiner argues that the col. 3, lines 62-col. 4, line 7 discloses a document browser. However, the text of Chang shows that this is clearly not the case. Col. 3, lines 62-64 describes a *user* browsing (i.e., using his or her *eyes*) documents on a network. In fact, it seems that the documents being viewed by the user have no links. The *user* can then look for "hypermedia nodes" that the *user* considers to be a link between documents. The *user* then generates a user-generated link to link the *user-selected* hypermedia nodes. No part of the recited portion of Chang discloses a "document browser," as claimed in claim 18. Clearly, the combination of Rodkin, Liu, Foss and Chang does not teach or suggest "utilizing a document browser, said document browser *for viewing and following links from one document to another*," as essentially claimed in claim 18.

Regarding claim 26, the Examiner argues that col. 6, lines 52-58 of Chang teaches a user selecting a link. Assuming, *arguendo*, that the Examiner's argument is true, the recited portion of Chang does not teach "said link browser invoking the means for link

interpretation for determining actions to be taken.” The recited portion of Chang simply teaches a user refining the link (i.e., making adjustments), which Applicants previously asserted. Thus, the combination of Rodkin, Liu, Foss and Chang does not teach or suggest “said link browser invoking the means for link interpretation for determining actions to be taken when a link is selected,” as essentially claimed in claim 26.

D. Conclusion

It is further asserted that the Examiner entirely ignored the Applicants detailed, scientific and substantive reasons why the recited cannot be combined. The Examiner provides only a speculative motivation to combine the references. It is respectfully reminded also that the motivation to combine the references *must* be motivation that existed *at the time of the prior art*. Unless the Examiner can establish that the motivation provided existed at the time of the prior *and* that the combination is even scientifically possible (i.e., rebutting the Applicants’ previously provided substantive reasons why the recited references cannot be combined), then prima facie obviousness cannot be established.

Accordingly, claim 1 is believed to be patentably distinguishable and nonobvious in view of Rodkin, Liu and Foss. Claims 7, 9, 18, 20 and 26 are believed to be patentably distinguishable and nonobvious in view of Rodkin, Liu, Foss and Chang. Dependent claims 2-6 are believed to be allowable for at least the reasons given for claim 1. Dependent claims 8, 10-17, 19, and 21-25 are believed to be allowable for at least the reasons given for claims 7, 9, 18, 20 and 26. Withdrawal of the rejection of 1-26 under 35 U.S.C. §103(a) is respectfully requested.

In view of the foregoing remarks, it is respectfully submitted that all the claims now pending in the application are in condition for allowance. Early and favorable reconsideration is respectfully requested.

Respectfully submitted,

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